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EXAMINER

TARAE, CATHERINE MICHELLE

ART UNIT	PAPER NUMBER
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3623

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/25/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/988,567

Applicant(s)

WILLIAMS, CONSTANCE A.

Examiner

C. Michelle Tarae

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 1,2,6,10 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-5 and 7-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The following is a Non-Final Office Action in response to the communication received on October 23, 2006.

Claims 1-11 are currently pending. Claims 3-5 and 7-9 have been elected and are rejected below. Claims 1-2, 6 and 10-11 are withdrawn from further consideration.

Claim Objections

2. Claim 9 is objected to because of the following informalities: Claim 9 does not appear to be a complete sentence. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 3-5 and 7-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

It is not clear how three process theory techniques are used to solicit nuggets in the form of visual images and metaphors from a group of individuals as recited in claim 3 since claim 3 just says using three process theory techniques, but is not explicit in

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terms of how and in what manner. When one refers to the specification for clarification on this, page 3 of the specification describes what three process theory is and pages 4-10 describe the steps for determining motivation of consumer interest in an item, but nowhere does it clearly describe how the steps in pages 4-10 use the Selective Combination, Selective Comparison and Selective Encoding, which are as described as part of the three process theory definition on page 3.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 3-5 and 7-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3-5 and 7-9 are rejected under this heading for the same reasons above. It is not clear how three process theory techniques are used to solicit nuggets in the form of visual images and metaphors from a group of individuals as recited in claim 3 since claim 3 just says using three process theory techniques, but is not explicit in terms of how and in what manner. Further, when one refers to the specification for clarification on this, page 3 of the specification describes what three process theory is and pages 4-10 describe the steps for determining motivation of consumer interest in an item, but nowhere does it clearly describe how the steps in pages 4-10 use the Selective Combination, Selective Comparison and Selective Encoding, which are as described as part of the three process theory definition on page 3. It appears that the

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steps described in pages 4-10 may be using Selective Combination, Selective Comparison and Selective Encoding without explicitly saying so. It appears this way by comparing the definitions of Selective Combination, Selective Comparison and Selective Encoding on page 3 with what the steps are actually performing on pages 4-10.

Accordingly, for examination purposes, Examiner will interpret the steps of claim 3 to be steps derived from the three process theory techniques. However, Applicant is respectfully requested to clarify this issue and particularly point out to where on pages 4-10 the three process theory techniques are implemented.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 3-5 and 7-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. According to MPEP 2106, the claimed invention as a whole must produce a "useful, concrete and tangible" result to have a practical application in order to be considered statutory.

The steps of claim 3 do not appear to be able to be reproduced and achieve the same or predictable results after each reproduction as they are related to 1) soliciting information from consumers using techniques that are not expressly recited, 2) deriving data from the information that may or may not be directly relevant to the consumers' motivations of an interest in an item, and 3) analyzing the derived data with other

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derived data to hypothesize reasons for consumers' motivations. All of these steps appear to use non-objective standards for being performed, resulting in different results each time the steps are implemented by a different person. Therefore, claim 3 does not appear to produce predictable or reproducible results and is thus, considered not concrete.

Additionally, the limitations discussed above are also considered not tangible as they do not provide a "real world" result to the user. For example, they do not actually display or provide to the user the hypothesized motivations of consumers, or use a tangible medium such as a computer or processing device to hypothesize the motivations of consumers.

Therefore, claims 3-5 and 7-9 are considered not concrete and not tangible and are thus, directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 3-5 and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Mick et al., "A projective study of motivations and meanings of self-gifts: implications for retail management," *Journal of Retailing*, 1992.

As per claim 3, Mick et al. discloses a method of determining motivation of consumer interest in an item by evaluating consumer language and/or semiotics, the method comprising:

a) a step for using three process theory techniques to solicit nuggets in the form of visual images and metaphors from a group of individuals (page 3; The women were asked to tell a imaginary stories relating to pictures shown to them, where the pictures were related to women buying perfume. In being provided with imaginary stories related to visual images shown to women consumers, the informant is soliciting nuggets from a group of individuals. Mick et al. is performing three process theory techniques in his description of how his research is conducted in determining women's perfume purchase motivations, based on Examiner's interpretation of how Applicant's present invention is using three process theory techniques as described in pages 4-10 of the specification.);

b) a step for evaluating the derived nuggets using word association, metaphors, analogies and/or absurd and irrelevant connections to derive one or more geodes (page 4; After the women's stories were transcribed, they were analyzed using context analytic procedures to derive meanings.);

c) a step for analyzing the geodes as they relate to the item of interest using the comparisons with other data combinations of geodes and encoded messages to hypothesize reasons consumers may be motivated as they appear to be relative to the item in question (pages 4-6; The stories were first categorized into seven categories based on story content and then further categorized into three more categories based

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on story grammar. The analysts then further analyzed the geodes by making comparisons with prior self-giving findings and relevant marketing and psychological research and concluded with inferences as to the women's motivations.).

As per claim 4, Mick et al. discloses wherein the steps a), b) and c) comprise using a focus group and facilitator (last two paragraphs on page 2; A group of women were selected as a focus group for analyzing consumer motivations for perfume purchases.).

As per claim 5, Mick et al. discloses wherein the soliciting nuggets involves the facilitator asking questions that have indirect relevance to the item of interest (page 3; The women were asked to tell imaginary stories relating to pictures shown to them. The pictures were a part of a Thematic Apperception Test (TAT), which is intended to provoke irrational or emotional responses from test subjects based on 'fictitious characters or circumstances. Thus, in being imaginary, the stories are indirectly related to the perfume purchase.).

As per claim 7, Mick et al. discloses wherein the evaluating nuggets comprises drawing pictures, creating collages, role playing, and posing paradoxes (page 3; The women were asked to tell imaginary stories relating to pictures shown to them.).

As per claim 8, Mick et al. discloses wherein the analyzing the geodes involves the step for synthesizing and converging existing geodes into insights of new patterns and combinations of terms having relevance to the item in question (page 4; The women's responses/stories were analyzed for similarities and differences and then grouped according to themes/patterns related to purchasing perfume.).

As per claim 9, Mick et al. discloses wherein the step for synthesizing the insights to achieve a rational or meaning more directly relating the previously defined insight into an insight directly relevant to consumer interest in the item (page 4; top of page 7; last paragraph on page 8; last two paragraphs on page 9; The women's responses/stories were analyzed for similarities and differences and then grouped according to themes/patterns related to purchasing perfume. Insights suggesting brand and cost motivations relevant to purchasing perfume were derived from analyzing the women's stories.).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Knight (U.S. 6,313,833) discusses graphical data collection interface for capturing user rationale and logic for purchasing decisions;
- Abelow (U.S. 5,999,908) discusses a customer-based product design module.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Michelle Tarae whose telephone number is 571-272-6727. The examiner can normally be reached Monday – Friday from 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached at 571-272-6729.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



C. Michelle Tarae
Primary Patent Examiner
Art Unit 3623

January 20, 2007